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09/689,245	10/11/2000	David Wayne Kelleher	G&C 139.142-US-U1	7831

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EXAMINER

IQBAL, KHAWAR

ART UNIT PAPER NUMBER

2686

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/689,245

**Applicant(s)**

KELLEHER, DAVID WAYNE

**Examiner**

Khawar Iqbal

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-11,13-15,17-25,27-29,31-39 and 41-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-11,13-15,17-25,27-29,31-39 and 41-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1,3-9,11,13-23,25,27-37,39,41-42 are rejected under 35 U.S.C. 102(e) as being unpatentable by Aravamudan et al (6301609).

3. Regarding claim 1 Aravamudan et al teaches a method for enabling cellular instant messaging comprising (abstract, figs. 1-9):

receiving a telemetry message that comprising a remote feature activation message wherein telemetry message indicates the availability on a cellular network of a first cellular phone (col. 7, line 15-col. 8, line 4);

storing information regarding the first cellular phone in an instant messaging database, wherein the information comprises a buddy list (col.4, lines 30-45, col. 6, lines 10-30, col. 9, lines 55-65); and

transmitting a browser alert to one or more relevant buddies identified in the buddy list (col.7 lines 1-40, col. 8, lines 35-45, col. 8, line 60-col. 9, line 25).

Regarding claim 11 Aravamudan et al teaches a method for enabling cellular instant messaging comprising (abstract):

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transmitting, from a first cellular phone, a telemetry message comprising a remote feature activation message wherein telemetry message indicates the first cellular phone's availability on a cellular network (col.6, lines 10-45, col. 7, line 15-col. 8, line 4, col. 9, lines 55-65);

receiving a browser alert, on the first cellular phone, indicating availability of buddies on a buddy list of the first cellular phone (col. 7 lines 1-40, col. 8, lines 35-45, col. 8, line 60-col. 9, line 25).

Regarding claim 15 Aravamudan et al teaches a system for enabling cellular instant messaging comprising (abstract, figs. 1-9):

an instant messaging database configured to maintain information regarding a first cellular phone, wherein the information comprises a buddy list (col. 4, lines 30-45, col. 6, lines 10-30, col. 9, lines 55-65);

a cellular network; and a server configured to:

receive a telemetry message comprising a remote feature activation message from a cellular phone wherein telemetry message indicates the availability of the first cellular phone on the cellular network (col. 7, line 15-col. 8, line 4); and

transmit a browser alert to one or more relevant buddies identified in the buddy list (col. 7 lines 1-40, col. 8, lines 35-45, col. 8, line 60-col. 9, line 25).

Regarding claim 25 Aravamudan et al teaches a system for enabling cellular instant messaging comprising a first cellular phone configured to (abstract):

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transmit a telemetry message comprising a remote feature activation message wherein telemetry message indicates the first cellular phone's availability on a cellular network (col. 6, lines 10-45, col. 7, line 15-col. 8, line 4, col. 9, lines 55-65);

receive a browser alert indicating availability of buddies on a buddy list of the first cellular phone (col. 4, lines 30-45, col. 6, lines 10-30, col. 9, lines 55-65).

Regarding claim 29 Aravamudan et al teaches an article of manufacture comprising a program storage medium readable by a computer hardware device and embodying one or more instructions executable by the computer hardware device to perform a method for enabling cellular instant messaging, the method comprising (abstract):

receiving a telemetry message comprising a remote feature activation message wherein telemetry message indicates the availability on a cellular network of a first cellular phone (col. 7, line 15-col. 8, line 4);

storing information regarding the first cellular phone in an instant messaging database, wherein the information comprises a buddy list (col. 4, lines 30-45, col. 6, lines 10-30, col. 9, lines 55-65); and

transmitting a browser alert to one or more relevant buddies identified in the buddy list (col. 4, lines 30-45, col. 6, lines 10-30, col. 9, lines 55-65).

Regarding claim 39 Aravamudan et al teaches an article of manufacture comprising a program storage medium readable by a computer hardware device and embodying one or more instructions executable by the computer hardware device to

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perform a method for enabling cellular instant messaging, the method comprising  
(abstract):

transmitting, from a first cellular phone, a telemetry message comprising a remote feature activation message wherein telemetry message indicates the first cellular phone's availability on a cellular network (col. 6, lines 10-45, col. 7, line 15-col. 8, line 4 col. 9, lines 55-65);

receiving a browser alert, on the first cellular phone, indicating availability of buddies on a buddy list of the first cellular phone (col. 7 lines 1-40, col. 8, lines 35-45, col. 8, line 60-col. 9, line 25).

Regarding claims 3,4,13,14,17,18,27,28,31,32 and 40,41 Aravamudan et al teaches wherein the telemetry message is a registration notification message and the telemetry message further indicates that a cellular phone has been powered on and the information further comprises a customer's profile for the cellular phone (col. 2, lines 25-45 and see above).

Regarding claims 5-7,19-21,33-35 and 42 Aravamudan et al teaches wherein the instant messaging database is maintained by an instant messaging partner (col. 4, lines 30-45, col. 6, lines 10-65, see above).

Regarding claims 8,9,22,23 and 36,37 Aravamudan et al teaches wherein the one or more relevant buddies comprise buddies on the first cellular phone's buddy list and wherein the one or more relevant buddies comprise computers connected to the Internet (col. 6, lines 10-65, see above).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10,24,38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aravamudan et al (6301609) and further in view of Godlewski (6421354).

Regarding claims 10,24 and 39 Aravamudan et al does not specifically teach utilizing a short message service to deliver text messages using the cellular phone. On the other hand, Godlewski from the same field of endeavor discloses utilizing a short message service to deliver text messages using the cellular phone (col. 14, lines 1-20).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Aravamudan et al by specifically adding short message service for the purpose of increasing efficiency of the system taught by Godlewski.

6. Claims 43-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aravamudan et al (6301609) and further in view of Larkins (6295291).

7. Regarding claims 43-54 Aravamudan et al teaches a client subscribing to the Communication Services Platform with Instant Messaging Service has an incoming voice call. The incoming call is directed to the client's Communication Services Platform. The services executive 164 directs the network as to how it should proceed with the voice call. The services executive 164 maintains a plurality of rules and real

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term events which may, for example, direct the network services interface 162 to complete the voice call to a particular phone number, or it may determine that the voice call should be directed to a particular e-mail address, or it may determine that the voice call should be placed on hold while attempts are made to locate the present location and interface over which the client may be reached (col. 5, lines 52-67). Aravamudan et al does not specifically teach as a roaming cellular phone desiring to activate/deactivate a feature.

In an analogous art, Larkins teaches a roaming cellular phone desiring to activate/deactivate a feature (col. 5, line 66-col. 6, lines 13)). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Aravamudan et al by specifically adding feature roaming cellular phone in order to enhance system performance, enables to provide various feature from the service provider for roaming mobile terminals as taught by Larkins.

### **Response to Arguments**

Applicant's arguments filed 03-18-05 have been fully considered but they are not persuasive. Examiner has thoroughly reviewed applicant's arguments but firmly believes the cited reference to reasonably and properly meets the claimed limitations. Applicant's argument was that "receiving a telemetry message that comprising a remote feature activation message wherein telemetry message indicates the availability on a cellular network of a first cellular phone". In response, examiner would like to point out that Aravamudan et al teaches varying priority assigned to respective "buddies" included in the "buddy list", and keywords which if included in data, a message, or a



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communication determine the priority or importance of that data, message, or communication. The personal data and rules database also maintains the online status and location of the client and locatable presence reachable from multiple networks for a subscribing client (col. 6, lines 5-64), the IM server also notifies selected buddies to the user of the users presence online, the CSP updates the CSP database to indicate that the user is online, which CPE device the user is utilizing to access the network, and the address to which the CPE device is attached, this feature may also be implemented in the client CPE software and is utilized to determine when the user is inactive for a predetermined period of time, and therefore possibly away from a CPE device which is registered as online, the previous state was inactive, then the CPE device generates an active message and conveys the active message to the CSP via the Instant Message server, the CPE device generates an inactivity message and conveys the inactivity message to the CSP via the IM server. Upon receiving the inactivity message, the CSP updates its database to indicate that the user is inactive (col. 7, linen 10-67).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpreted by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Khawar Iqbal whose telephone number is (571) 272-7909.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

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more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

*Khawar Iqbal*



**CHARLES APPIAH**  
**PRIMARY EXAMINER**